

TTAB

TRADEMARK  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRIAL AND APPEAL BOARD**

**NY-EXOTICS, INC.**  
**Petitioner**

**vs.**

**EXOTICS.COM, INC.**  
**Registrant**

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**Cancellation No.**

**Registration No.: 2,576,808**

**Date of Issue: June 4, 2002**

**EL654515093US**

Commissioner for Trademarks  
BOX TTAB FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57  
08-08-2002

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on	<b>8-8-02</b> <i>Gale Dwyer</i>
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TRADEMARK TRIAL AND APPEAL BOARD

**PETITION FOR CANCELLATION**  
**(Original & Duplicate)**

Madam/Sir:

Petitioner, NY-Exotics, Inc., a corporation of the State of New York, having an office and principal place of business at 1350 Broadway, Suite 1213, New York, New York 10018, believes that it is and will be damaged by U.S. Registration 2,576,808, and hereby petitions to cancel the same.

As grounds for this petition, it is alleged that:

1. Registration No. 2,576,808 for the mark NY-EXOTICS.COM issued on June 4, 2002, for use in connection with "providing a web site on a global computer network featuring consumer information on the subjects of luxury watercraft, catamarans,

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personal recreational watercraft, sports equipment, canoes, kayaks, luxury automobiles, motorcycles, home accessories, clothing, jewelry, watches, fashion accessories, lingerie, fine wine, liquor, cigars, electronics, flowers, toys, books, videos, DVDs, DCDs, timeshares, travel, vacations, cruises, film, music sports, gambling, adult entertainment, exotic dancers, parasailing, fishing, entertainment, fashion, art, antiques, masseuses, restaurants, resorts, homes, ranches, condominiums, townhouses, interior design, lifestyle and other topics of general interest" in International Class 035.

2. Petitioner filed an application with the U.S. Patent and Trademark Office on September 27, 2001, Serial No. 76/318,359 to register NY-EXOTICS for use in connection with "providing advertising services for business, namely on line advertising by means of a global network" in International Class 035.

3. Petitioner is now and has continuously been engaged in providing advertising services since at least October of 1997.

4. The U.S. Patent and Trademark Office has rejected Petitioner's application by citing Registrant's registration.

5. Registrant is not entitled to maintain Registration No. 2,576,808 because, upon information and belief, Registrant is not the owner of the mark NY-EXOTICS.COM, which is grounds for cancellation, based on the following:

a. Petitioner entered into a License Agreement dated October 15, 1997, as amended by amendments dated November 5, 1998, April of 2000 and March 5, 2001 (the "License Agreement") with Exotics USA LLC, a Georgia corporation, whereby Petitioner was granted by Exotics USA LLC an exclusive license to sell advertising through a website entitled "NY-Exotics.com", and in conjunction therewith to use such NY-EXOTICS.COM as a mark to identify the advertising services offered via that website. Under the License Agreement, Exotics USA LLC represented and warranted to Petitioner that it was the sole owner of all rights, title and interest in and to such website and the names and descriptions used in connection therewith. Under the License

Agreement, Exotics USA LLC is further acknowledged as the exclusive owner of the trademarks used in conjunction with such website, which would include without limitation, the mark NY-EXOTICS.COM.

b. Petitioner is the current owner of all trademarks licensed by Exotics USA LLC to Petitioner under the License Agreement, including without limitation the NY-EXOTICS.COM mark. The License Agreement was terminated for material, uncured breach of Exotics USA LLC on October 9, 2001 and such termination was reaffirmed on December 6, 2001. The License Agreement, by its own terms, provided that all trademarks (including without limitation the NY-EXOTICS.COM mark) licensed by Exotics USA LLC to Petitioner would revert wholly and automatically to Petitioner upon termination due to breach of the License Agreement by Exotics USA LLC, and Exotics USA LLC would make no further use of such rights for any purpose whatsoever. Since October 9, 2001, Petitioner has continuously used the mark NY-EXOTICS.COM in conjunction with its advertising services.

c. Registrant is the parent corporation of Exotics USA LLC and, by its actions, it has affirmed the License Agreement. The specimen of use filed by Registrant to obtain U.S. Registration 2,576,808 is actually an advertisement for Petitioner's services placed by Petitioner pursuant to its exclusive rights under the License Agreement.

6. By reason of the foregoing, Petitioner will be damaged by the Registrant's continued registration of the mark NY-EXOTICS.COM, Registration No. 2,576,808.

WHEREFORE, Petitioner respectfully request that this Cancellation be sustained and that the Registrant's registration be canceled.


A check of Jenkins & Gilchrist, a Professional Corporation, in payment of the required \$200.00 filing fee for a Cancellation Petition of the mark is enclosed. In the event the check is not received with this correspondence or if additional fees are due,

please charge the required fees to deposit account no. 10-0447. Please credit any overpayment to the deposit account.

Please file-stamp and return the attached postcard in acknowledgement of receipt of this correspondence and check.

**NY-Exotics, Inc., Petitioner**

Date: 8-8-02

By:   
Cathryn A. Berryman  
Attorney for Petitioner

Jenkins & Gilchrist,  
A Professional Corporation  
1445 Ross Avenue  
Suite 3200  
Dallas, TX 75202-2799  
(214) 855-4731  
(214) 855-4300 (facsimile)